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EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,566

Applicant(s)

BECKER, THOMAS

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-78 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-93 of copending Application No. 10/037,188. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between the present claims and the copending claims is that the present claims claim that the panel is synthetic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material for the panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the grommet (claims 27 and 49) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: On page 7, lines 25 and 26, element "207" is disclosed as being "the front surface" and "a cutout". Appropriate correction is required.

Claim Objections

4. Claim 3 is objected to because of the following informalities: In claim 3, line 2, "labeled" should be replaced with "label". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, line 1, "said ink" lacks proper antecedent basis.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4-13, 18, 20, 33, 36, 38-41, 55, 56, 58, 59 and 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlquist (6,080,094).

Dahlquist discloses an advertising device (20) for direct mail delivery to a recipient comprising a panel having a back side (as seen in figure 11), a front side (as seen in figure 8), at least one of the back side and front side adapted to receive delivery information (as seen in figure 11, delivery information (mailing address) is located on the panel), and a thickness sufficient to maintain integrity of the panel.

Dahlquist discloses the claimed invention except for explicitly disclosing the panel being of a synthetic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material for the panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 4, 5, 36, 39, 58, Dahlquist discloses the claimed invention except for the specific arrangement and/or content of indicia (i.e., panel comprising a theme related to at least one of a product and a service) set forth in the claim (for

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example, claims 4, 5, 32 and 53). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired information on the panel, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of advertising device does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.

Regarding claims 5-7, Dahlquist discloses a cutout (36 – die cut opening) in the front panel.

Regarding claim 8, it is inherent to the Dahlquist's invention that the cutout would be implemented when the panel is manufactured/molded.

Regarding claims 9 and 10, the cutout is such that the address information is visible, thus providing an outline of the print pattern (wherein the print pattern is the address information).

Regarding claim 11, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide a multicolored printed image, since matters related to the choice of ornamentation producing no mechanical effect or advantage considered

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to constitute the invention are considered obvious and do not impart patentability. *In re Seid*, 73 USPQ 431.

Regarding claim 12, Dahlquist discloses providing promotional messages on the panel (see col. 3, lines 59-66).

Regarding claim 13, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the same printed indicia on the front and back panels, since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 18 and 20, see the above rejections with respect to material selection.

Regarding claims 33, 34, 36, 38-41 the method of delivering an advertisement device by direct mail delivery to a recipient is inherently disclosed in the above rejections.

Regarding claim 55, Dahlquist discloses an advertisement device system as set forth in the above rejections.

Regarding claim 56, Dahlquist does not explicitly disclose the method for printing the delivery information onto the panel, however, the claimed printing methods (silk screening, sheet fed printing, web offset printing, web letter press printing, gravure printing and ink jet printing) are all conventional in the art. It would have been obvious to one having ordinary skill in the art to select any of the conventional printing methods as deemed necessary by the end user.

Regarding claims 59, 61, 62 and 64, see the above rejections to claims 5-7.

Regarding claim 63, see the above rejections to claim 8.

9. Claims 14-17, 19, 21, 37, 42-44, 60 and 68-70, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlquist in view of Aamodt et al. (6,325,969).

Dahlquist discloses the claimed invention except for the advertising device having an anti-microbial agent on the panel.

Aamodt et al. disclose a paper material that can be impregnated with at least one chemical material. In one embodiment of Aamodt et al. the paper is impregnated with a gaseous peracetic acid that diffuses out of pores in the paper, creating a no-growth zone on the surface of the paper (see col. 1, lines 10-17, 28-35 and 51-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Dahlquist's invention to include an anti-microbial agent on the panel, as taught by Aamodt et al., to provide a "paper product which can inhibit the growth of microorganisms..." (see col. 1, lines 47-49).

10. Claims 3, 35 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlquist in view of Steitz (6,412,687).

Dahlquist discloses the claimed invention except for the delivery information being preprinted on a separate label and applied to a surface of the panel.

Steitz discloses a pressure seal C-Z fold mailer wherein delivery information (reply address) can be preprinted on an adhesive address label to be attached to the

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mailer (see col. 3, lines 27-31). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Dahlquist's invention to include adhesive labels that can be applied to the panel, as taught by Steitz, as an alternative method of providing the information to aid in delivery of the envelope.

11. Claims 22-25, 45-47, 65-67 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlquist in view of Petkovsek (5,626,370).

Dahlquist discloses the claimed invention except for a means for attaching the device to a surface.

Petkovsek discloses a one-piece mailing form (100) having adhesive areas (108) for attaching the mailing form to a package (102) (as seen in figure 10). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Dahlquist's invention to include adhesively attaching the device to a surface, as taught by Petkovsek, for mailing packages and other related items to a recipient.

12. Claims 26-28, 48-50 and 72-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlquist in view of Petkovsek and further in view of Didiano, Jr. (5,927,495).

Dahlquist, as modified by Petkovsek, discloses the claimed invention except for the mechanism for holding the device with respect to a surface being a hole in the device.

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Didiano, Jr. discloses a mailer box product (10) comprising a hole (70) near the top of the panel (50) (see col. 4, lines 24-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Dahlquist's invention to include a hole in the device, as taught by Didiano, Jr., for displaying the mailer device on conventional pegs in a variety of retail shops.

Note: the use of grommets in holes is conventional in the art and it would have been obvious to one having ordinary skill in the art to provide a grommet in the hole of Dahlquist, as modified by Aamodt et al., Petkovsek, and Didiano, Jr.

13. Claims 29, 30, 32, 51, 52, 54, 75, 76 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlquist in view of Haan et al. (5,458,284).

Dahlquist discloses the claimed invention except for a mechanism to carry another item.

Haan et al. discloses a mailer having a plurality of credit cards (C) releasably secured to the panel by a hot-melt adhesive (see col. 14, lines 40-59 and figure 18). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Dahlquist's invention to include cards secured to the panel of the device, as taught by Haan et al., to provide the recipient with promotional coupons, identification cards, and the like.

14. Claims 31, 53 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahlquist in view of Haan et al. and further in view of Pace et al. (6,126,201).

Dahlquist, as modified by Haan et al., discloses the claimed invention except for the mechanism to carry another item comprising a shrink wrap material to hold the item to the device.

Pace et al. disclose a folder (50) for mailing items comprising a compact disc assembly (80) including a base portion (82), a compact disc (52) and a covering (84) formed from a pliable, transparent material. The compact disc (52) may be conveniently shrink-wrapped with the packaging media on the base portion. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Dahlquist's invention to include shrink wrapping the item to the panel, as taught by Pace et al., to securely fasten the item to panel until it is to be used by the recipient.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose substrates having anti-microbial agents.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone

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numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

February 23, 2003

Monica Carter
MONICA CARTER
PATENT EXAMINER